

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TSUYOSHI KITAHARA

Appeal 2007-2391
Application 09/708,514
Technology Center 2800

Decided: September 26, 2007

Before JAMES D. THOMAS, KENNETH W. HAIRSTON, and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1, 3, 4, and 54. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a).

In an earlier appeal involving this application, captioned as Appeal No. 2006-2395, we issued on December 14, 2006 a remand to the Examiner

to clarify on the record which reference was relied upon as evidence of anticipation and unpatentability of the same appealed claims. In a supplemental Answer mailed on January 18, 2007, the Examiner did clarify that the reference to Nakamura (characterized as JP 08-187868) was the reference the Examiner intended to rely upon. Correspondingly, Appellant's supplemental Reply Brief on March 19, 2007 relied for patentability upon arguments submitted in the previous Brief filed on January 13, 2005 and the corresponding Reply Brief, received on May 9, 2006, to the original Examiner's Answer mailed on March 10, 2006. After these prior proceedings, a new Appeal No., captioned above, has been assigned to this appeal.

As best representative of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. An ink-jet recording head comprising:

a pressure producing device for changing a pressure in a pressure chamber containing an ink;

a plate-shaped member having a front surface and a back surface, the plate-shaped member having an etched partition wall formed on the front surface, the partition wall defining the pressure chamber, an ink inlet passage and a common ink storage chamber, the plate-shaped member having an etched land formed on the back surface so as to correspond to the pressure chamber and be in contact with an extremity of the pressure producing device, the plate-shaped member having an etched elastic and deformable portion so as to surround the land, the elastic and deformable portion being capable of being elastically deformed by a deformation of the pressure producing device; and

a nozzle plate provided with a nozzle hole through which an ink particle is jetted when the pressure in the pressure chamber is changed by the

deformation of the pressure producing device, the nozzle plate being disposed on a side of the front surface of the plate-shaped member,

wherein the plate-shaped member includes a first layer having the front surface, a second layer having the back surface and an intermediate layer sandwiched between the first layer and the second layer, and

wherein the partition wall is formed such that a desired portion of the first layer selectively is etched over the intermediate layer so that the first layer is penetrated, and the land is formed such that a desired portion of the second layer is etched selectively over the intermediate layer so that the second layer is penetrated.

The following references are relied upon by the Examiner:

Usui	US 6,158,847	Dec. 12, 2000 (filed May 14, 1997)
Nakamura	JP 08-187868	Jul. 23, 1996

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Nakamura. Claims 3, 4, and 54 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the Examiner relies upon Nakamura in view of Usui.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the earlier-noted Briefs for Appellant's positions, and to the earlier-noted Answers for the Examiner's positions.

OPINION

Generally, for the reasons set forth by the Examiner in the supplemental Answer, as amplified here, we sustain the rejection of independent claim 1 under 35 U.S.C. § 102 as well as the rejection of remaining claims 3, 4, and 54 under 35 U.S.C. § 103.

Beginning with the Examiner's analysis of independent claim 1 at page 3 of the supplemental Answer, the Examiner recognizes that Nakamura does not teach the process features recited in this apparatus claim, but the view is taken that this claim is not further limited by the process limitations of "etched" because these processes do not further define any structure of the claimed apparatus. This position is clarified at page 5 of the supplemental Answer where the Examiner makes note that the repeated use of the word "etched" in representative independent claim 1 on appeal invokes a product-by-process analysis in accordance with MPEP § 2113. The Examiner's analysis appears to be correct.

When claims are directed to a "product-by-process," it is the patentability of the product claimed and not of the recited process which must be established. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985).

Appellant does not contest the requirement that distinctive structural/physical characteristics must result from the claimed process of etching various elements in representative independent claim 1 on appeal. Instead, Appellant effectively acknowledges this requirement and urges that patentability naturally follows because an etched surface provides unique physical properties and several of the disclosed advantages are said to naturally follow. Page 5 of the supplemental Answer addresses the arguments in the principal Brief but also urges that Appellant has not met his burden of proof as to why etching yields a different structure.

It is our view that the Examiner's rejection of the instant product-by-process claims over the device of Nakamura was appropriate given that the

product of Nakamura appears to be identical, albeit produced by a different process, to the product claimed by the Appellant. Such a rejection shifts the burden upon Appellant to come forward with evidence establishing a difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983).

Moreover, apart from Appellant's arguments, Appellant has provided no factual evidence on this record proving otherwise. It is well settled that mere lawyer's arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); *In re Wood*, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978); *In re Lindner*, 457 F.2d 506, 508-09, 173 USPQ 356, 358 (CCPA 1972).

In view of the foregoing, and because Appellant has not otherwise contested the Examiner's reliance upon Nakamura as evidence of anticipation of independent claim 1 on appeal, we sustain the first stated rejection.

Because page 16 of the principal Brief relies for patentability on the arguments presented for the first stated rejection with respect to Nakamura under 35 U.S.C. § 103 and does not contest the Examiner's additional reliance upon Usui as to independent claim 3 and dependent claims 4 and 54, we sustain the rejection of them as well. There has been no allegation made before us that Nakamura and Usui would not have been properly combinable within 35 U.S.C. § 103.

In view of the foregoing, the decision of the Examiner rejecting various claims on appeal under 35 U.S.C. §§ 102 and 103 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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